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Customer No.: 07278
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Docket No: 2567/1F496-US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Andrew EISEN

Serial No.: 10/031,893 Art Unit: 1652

Confirmation No.: 8212

Filed: July 19, 2002 Examiner: Richard G. Hutson

For: **DROSOPHILA RECOMBINATION-ASSOCIATED PROTEIN AND METHODS FOR USE**

RESPONSE TO OFFICE ACTION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

May 22, 2003

Sir:

This responds to the Office Action mailed April 22, 2003 in the above-referenced application. In response to the election/restriction requirement set forth in the Office Action, Applicant elects examination of Group I, claims 8, 10, 11, 18 and 19. Applicant, however,

specifically requests modification of invention Group I, as set forth below. More generally, the restriction requirement is respectfully traversed.

(i) Request for Modification. Applicant respectfully requests modification of invention Group I to include claims 8, 10, 12, 16, 18 and 19. As currently set forth, Group I comprises claims 8, 10, 18 and 19, drawn to DRAP polypeptide, and claim 11, drawn to a method of using DRAP polypeptide for isolating genomic DNA. Group III comprises claims 12 and 16 drawn respectively to methods of using DRAP polypeptide for targeting mutagenesis and promoting gene disruption of a defined segment of DNA. Applicant requests that the Group III claims 12 and 16 be joined to Group I claims 8, 10, 18 and 19, and that claim 11 be removed from Group I and placed in a separate invention Group. Applicant submits that examination of claims 12 and 16, which have been identified as a single invention group by the Examiner, would require no greater effort to examine than the effort required to examine claim 11, which they replace. Accordingly, examination of the modified Group I claims would place no further burden on the Examination than the examination of the present Group I claims.

In a telephone interview conducted May 22, 2003, the undersigned agent and Examiner Hutson discussed the proposed modification of invention Group I. The Examiner reserved a decision on the modification until a formal request was received in the instant response. The undersigned agent thanks the Examiner for the courtesy shown during the May 22 interview and renews the request for modification of invention Group I, as set forth above, accordingly.

(ii) Request for re-joinder of all claims. Applicant further respectfully traverses the restriction requirement and requests rejoinder of all claims. Contrary to the Examiner's position, the inventions set forth in Groups I through VII do in fact "form a single inventive

concept" under PCT Rule 13.1 because, under PCT Rule 13.2, there is a "technical relationship" among the inventions "involving" a "special technical feature." All of the inventions identified by the Examiner "involve" the "same or corresponding special technical feature," in that they all rely on DRAP polypeptide. Hence, Group I claims 8, 10, 18 and 19 are directed to the DRAP polypeptide. Group II (claim 9) is drawn to an antibody that specifically recognizes DRAP polypeptide. Each of the methods of Group I (claim 11) and Groups III-VII (claims 12-17) comprises a step of introducing DRAP polypeptide and an oligonucleotide into a cell. These methods are further united by the common action of DRAP polypeptide facilitating homologous recombination. Accordingly, the DRAP polypeptide is a technical feature that defines a contribution which each of the claimed inventions, considered as whole, makes over the prior art, as set forth in PCT Rule 13.2. There is therefore unity of invention among claims 8-19.[1] Examination of all the claims is therefore in order.

Applicant notes, finally, that during the international phase of the present application, the USPTO, acting in its capacities as the International Search Authority and the International Preliminary Examining Authority for the application, performed a search and issued a Written Opinion (signed by the present Examiner) on all of the original claims included in the international application, which included claims that were substantially similar to instant claims 8-19. Following amendment of the claims under PCT Rule 66.3, the USPTO issued a an International Preliminary Examination Report that included examination of claims identical to instant claims 8-19. No lack of unity of invention was found during either international Phase I or Phase II of the application. The USPTO has already examined instant claims 8-19. Hence, examination of claims 8-19 in the instant national phase of the application would be in accord

[1] Applicant submits that the Examiner's reasoning applies to restriction practice under 37 C.F.R. 1.140 et seq., not to Unity of Invention practice, as required for this national phase of a PCT application.

with the USPTO's previous determination that all of these claims should be examined together in a single application. For this reason additionally, all of claims 8-19 should be examined in the present application.

For all the reasons set forth above, Applicant respectfully submits that there is no lack of unity of invention among claims 8-19. The Examiner is therefore requested to rejoin all claims and examine them in a single application.

This request is not an admission that the inventions of Groups I through VII identified by the Examiner are not independent or patentably distinct. Applicant believes, in fact, that the Group I through VII claims are patentable over each other. This, however, is not a basis to restrict the claims, as they all share the technical relationship of the novelty of DRAP polypeptide.

The present claims are believed to be in condition for allowance. An early and favorable action on the merits of the application is earnestly requested.

Respectfully submitted,

Mitchell Bernstein, Ph.D.
Reg. No. 46,550
Agent for Applicant

DARBY & DARBY, P.C.
Post Office Box 5257
New York, NY 10150-5257
Phone (212) 527-7700